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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,936	01/05/2000	HARRY E. EMERSON	17617-46	9952

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

<b>Office Action Summary</b>	Application No. <b>09/477,936</b>	Applicant(s) <b>Emerson et al</b>
	Examiner <b>James W. Myhre</b>	Art Unit <b>3622</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on Oct 15, 2002
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-12 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some\* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
  - a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 15, 2002 has been entered.

### ***Response to Request for Reconsideration***

2. The Request for Reconsideration filed on August 20, 2002 under 37 CFR 1.116 has been considered but is ineffective to overcome the Chen (5,917,830) and Capek et al (6,094,677) references. However, additional prior art has been located which better discloses the invention and has been used in the rejection of all claims below.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (5,917,830) in view of Capek et al (6,094,677) and Wachob (5,155,591).

Claims 1 and 7: Chen discloses a system and method for substituting advertisements during a broadcast, comprising:

- a. Generating, digitizing, and storing a plurality of replacement commercials (e.g. advertisements) for insertion into the broadcast (col 4, lines 39-41 and col 13, lines 15-20);
- b. Marking the broadcast with the start and end times (e.g. duration) of the commercial (col 2, lines 18-21; col 6, line 66 - col 7, line 10; and col 13, lines 15-20);
- c. Receive the broadcast (col 13, lines 57-62);
- d. Detect and read the insertion marker on the broadcast (col 6, lines 1-10 and col 12, lines 36-37);
- e. Select and substitute (insert) a replacement commercial into the broadcast at a point corresponding to the insertion marker (col 8, lines 1-5 and col 14, lines 3-12); and
- f. Repeat the detection and insertion of replacement commercials throughout the broadcast (col 13, line 61 - col 14, line 7).

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While Chen uses a network television broadcast as an exemplary use of the invention, it is also disclosed that the invention can be applied “for splicing a secondary packetized data stream, such as a commercial, with a primary packetized data stream” (col 4, lines 7-9) and that the secondary packetized data streams (commercials) being inserted (spliced) “may include digital audio tapes” or “compact audio discs (CDS)” (col 4, lines 39-43) and that “audio only or data only messages may be inserted into the main packetized data stream” (col 4, lines 57-59). The Applicant’s invention is directed to inserting a replacement commercial into a radio broadcast being received via the Internet. The Examiner notes that both radio and television broadcasts may be received via the Internet, and that both are “packetized data streams”. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the packetized data stream into which Chen is inserting commercials could contain either audio/video data (i.e. television) or only audio data (i.e. radio). One would have been motivated to use Chen’s system and method to insert commercials into a radio broadcast in view of his disclosure of inserting audio only data and storing digital audio tapes.

Chen discloses replacing main stream commercials with the selected commercials (col 14, lines 7-12) and also discloses marking and detecting the start and end times of the insertion points ( $T_{in}$  and  $T_{out}$ ; col 13, lines 15-20). Additionally, Chen discloses that “the system should avoid any discontinuity which results in a non-compliant data stream. The data stream should also preclude problems such as syntax violations, decoding errors, buffer overflow or underflow, timing recovery problems due to discontinuous time stamps, audio/video synchronization

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problems, and video display artifacts" (col 1, line 65- col 2, line 3). While it is not explicitly disclosed that a comparison is made to determine whether the duration of the replacement commercial corresponds to the duration of the main stream commercial being replaced (based on the start and end times), it is inferred that such a comparison is being made in order to "avoid discontinuity" and "buffer overflow or underflow". Capek discloses a similar system and method for inserting commercials into data streams containing content information which also determines whether the duration of the insertion point is sufficiently long to allow insertion of a commercial (col 4, lines 43-51; col 5, lines 23-28; and col 9, lines 57-61). This infers that the duration of each stored replacement commercial is known and used in the determination (comparison). Wachob also discloses a similar system and method for providing targeted advertisements to users with a cable television broadcast as an exemplary use of the invention. Wachob further explicitly discloses that the targeted advertisement would replace the original advertisement in the broadcast and be selected based on the determination of "the length of the impending commercial message break" (col 7, lines 34-37) based on received tag information which "defines if and when a commercial is about to occur, how long it will last" (col 7, lines 18-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to compare the durations of the main stream commercial and the replacement commercial when selecting the replacement commercial in the Chen invention. One would have been motivated to compare these durations in order to decrease the likelihood of "blank time" during the reception of the broadcast if the replacement commercial was shorter than the main stream commercial or "overwriting" of

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the main stream broadcast (content) if the replacement commercial was longer than the main stream commercial.

Claim 2: Chen, Capek, and Wachob disclose a method and system for substituting advertisements during a broadcast as in Claim 1 above. Chen also discloses that the marking of the start and end times of the insertion point is performed by the broadcast station (col 6, line 66 - col 7, line 10 and col 13, lines 15-20).

Claim 3: Chen, Capek, and Wachob disclose a method and system for substituting advertisements during a broadcast as in Claim 2 above. Both Chen and Capek also disclose digitizing the audio stream into sequential packets to allow for presenting a series of packets in the proper order as one complete commercial (Chen, Fig. 6a, items A1-A11 and col 14, lines 56-65)(Capek, col 5, lines 14-16; col 7, lines 42-47; and col 8, line 59 - col 9, line 5).

Claims 4-6, 8, and 9: Chen, Capek, and Wachob disclose a method and system for substituting advertisements during a broadcast as in Claims 1, 2, 3, and 7 above. While Chen does not explicitly disclose using consumer demographics to select (target) the replacement commercial, Capek discloses that the information “may be customized to either the user or the material requested, or both” (col 4, lines 43-51 and col 8, lines 7-58) and that “the insertion manager 20 them selects a customized insertion based upon the client profile for the requesting client” (col 12, lines 32-39), or type of information requested (col 12, lines 34-39). Wachob also discloses selecting the targeted advertisement “based on the viewer’s demographic characteristics” (col 2, lines 62-65). Therefore, it would have been obvious to one having ordinary

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skill in the art at the time the invention was made to base the selection of the commercials in Chen upon the consumer's demographic information. One would have been motivated to use this type of selection in Chen in order to present commercials which are more pertinent to the consumer ("to increase the users interest and to make the information more engaging", Capek, col 7, lines 8-10), thus increasing the acceptance and interaction with the commercial by the consumer.

Claim 10: Chen, Capek, and Wachob disclose a method for substituting advertisements during a broadcast which performs steps (a) - (m) of Claim 1 and further performs the steps in which consumer demographic data and advertisement type information are stored and used to select the replacement advertisement as in Claims 4 and 5 above.

Claim 11: Chen, Capek, and Wachob disclose a method for substituting advertisements during a broadcast as in Claim 10 above. Chen further discloses that the marking of the start and end times of the insertion point is performed by the broadcast station as in Claim 2 above (col 6, line 66 - col 7, line 10 and col 13, lines 15-20).

Claim 12: Chen, Capek, and Wachob disclose a method for substituting advertisement during a broadcast as in Claim 11 above. Both Chen and Capek also disclose digitizing the audio stream into sequential packets to allow for presenting a series of packets in the proper order as one complete commercial as in Claim 3 above (Chen, Fig 6a, items A1-A11 and col 14, lines 56-65)(Capek, col 5, lines 14-16; col 7, lines 42-47; and col 8, line 59 - col 9, line 5).

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***Response to Arguments***

5. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

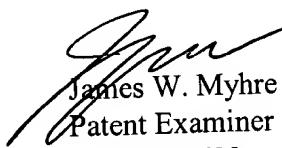
***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM  
November 7, 2002

  
James W. Myhre  
Patent Examiner  
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